

## **REMARKS**

Reconsideration of this application, as amended, is respectfully requested.

Initially, the Applicants would like to thank the Examiner for the indication that claims 2-4, 8-10, 13 and 16 contain allowable subject matter.

In the Official Action, the Examiner rejects claims 1, 5-7, 11, 12, 14, 15 and 17 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,719,763 to Chung et al., (hereinafter “Chung”).

In response, Applicants respectfully traverse the Examiner’s rejection under 35 U.S.C. § 102(e) for at least the reasons set forth below. However, independent claim 5 has been amended to clarify its distinguishing features. Furthermore, claims 1, 6, 7, 11, 12, 14, and 15 have been canceled thereby rendering the rejections thereof moot.

In response to the previous Official Action, Applicants argued that Chung does not disclose a clamping member that is configured to clamp living tissues and merely discloses a grasping/clamping member 8 configured to grasp suture threads. In the Final Official Action, the Examiner responds “a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.”

Applicants respectfully submit that the grasping/clamping member 8 of Chung is not capable of clamping living tissue. However, in the interest of advancing prosecution, independent claim 5 has been amended as discussed below to clarify its distinguishing features.

The endoscopic suture apparatus as recited in the claims comprises a suturing element having an engaging portion. The engaging portion is engaged as a puncture member penetrates living tissues while the living tissues are pulled into a treatment space by a holding forceps. Because the engaging portion is engaged with the tissues after penetration, the suturing element is set on the tissue so that the tissue can be sutured.

In contrast, Chung discloses a holding forceps that draws suture threads, which have been made to penetrate through tissues by a puncture member, to suture the tissues. However, the suture threads of Chung do not have a portion corresponding to the engaging portion provided on the suturing element of the present invention. Therefore, the device of Chung makes it necessary to hold and draw the suture threads by a holding forceps in suturing the tissues. That is, assuming *arguendo* that the holding forceps of Chung can hold and draw living tissues, the suture threads need to be held when the tissue is to be sutured. It is not possible for the device of Chung to continue the suture operation while holding the tissue.

In order to clarify such a distinction, claim 5 has been amended to recite

a suturing element which penetrates the living tissues by a penetration of the puncture member into the living tissues and is kept in the living tissues in a penetrating state to suture the living tissues; and

an engaging portion provided at an end portion of the suturing element, the engaging portion engaging with the living tissues to keep the suturing state of the suturing element in the living tissues.

Accordingly, independent claim 5 clearly distinguishes over Chung in the structure and effect that a suturing element is kept in living tissue in a penetrating state as an engaging portion provided on the suturing element is penetrated through the tissues, thereby enabling to perform both the penetration and the suture operations, in a state where the tissue is held by a holding member.

With regard to the rejection of claims 1, 5-7, 11, 12, 14, 15 and 17 under 35 U.S.C. § 102(e), an endoscopic suture apparatus having the features discussed above and as recited in independent claim 5 is nowhere disclosed in Chung. Since it has been decided that “anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,”<sup>1</sup> independent claim 5 is not anticipated by Chung. Accordingly, independent claim 5 patentably distinguishes over Chung and is allowable. Claim 17 being dependent upon claim 5, is thus at least allowable therewith (claims 6, 7, 11, 12, 14 being canceled). Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1, 5-7, 11, 12, 14, 15 and 17 under 35 U.S.C. § 102(e).

Lastly, new claims 18-23 have been added to further define the patentable invention. New claims 18-23 are fully supported in the original disclosure. Thus, no new matter has been entered into the disclosure by way of the addition of new claims 18-23. Furthermore, as discussed above, claims 1, 2, 6, 7, 11, 12, 14, and 15 have been canceled, therefore, at least an equal number of claims have been canceled as are being added in response to the Final Official Action.

Applicants respectfully submit that new independent claim 18 patentably distinguishes over Chang for at least the reasons discussed above and is allowable. Dependent claims 19-23 are at least allowable as depending upon an allowable base claim (18 and 5 either directly or through an intervening claim). Original claims 3 and 4 have been amended to depend from new claim 18, original claims 8 and 9 have been amended to depend from new claim 21 and original claim 13 has been amended to include the features of original claim 12 and to depend from new claim 22.

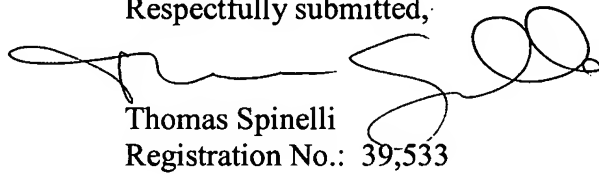
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<sup>1</sup> Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

Lastly, claim 16 has been amended to include the features of claim 15 and to depend from claim 5. Dependent claim 16 is at least allowable as depending from an allowable base claim (5).

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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